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09/728,340

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Tom Vicknair

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02/28/2006

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EXAMINER

DASS, HARISH T

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/728,340 | Applicant(s) VICKNAIR ET AL. | |
| | Examiner Harish T. Dass | Art Unit 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/22/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,36-41 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,36-41 and 43-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Canceled claims: 7, 11-35, 42 and 46-66.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 1 has limitation “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number”, where the function of “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number” is not described in specification clearly, which allows the examiner to under stand how the second item sequence number is discarded and then the second record is indexed by first item sequence number? It is not clear if the invention creates a composite list (table) and then troughs away the second record all together or clears (discards, removes or deletes) the second sequence number from the composite list.

Claim Objections

2. Claim 8 is objected because it refers to a canceled claim (claim 7). Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Examiner assumes claim 8 depends on claim 5.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-10 and 36-41 and 43-45 remain rejected Geer (US 5,930,778) in view of Josephson et al (hereinafter Josephson - US 5,532,464), Cahill et al (hereinafter Cahill - US 5,678,046), and Ramsay et al (hereinafter Ramsay – 5,502,576).

Re. Claims 1, Geer discloses a system for expedited processing of checks and cash items received by a payee, electronic files that mirror paper cash letters and detail records [see entire document particularly - Abstract; Figures 1-2; C1 L1 to C6 L20],

receiving an electronic cash presentment (ECP or transmission of the transactional check data) file, the ECP file containing first records representing paperbased banking transactions [C2 L4-L15; C4 L26 to C5 L9; C7 L25-61; C9 L1-L10; C18 L1-L18],

for each of the first records, assigning a unique first item sequence number to each respective first record [C7 L38-L58],

receiving the paper-based banking transactions after having received the ECP file, [C4 L45 to C5 L10; C10 L50-57],

generating second records representing the paper-based banking transactions [C15 L17-L19],

generating digital images of the paper-based banking transaction [C4 L26-L42; C8 L9-L67];

for each of the second records, assigning a unique second item sequence number to each respective second record [C13 L44-L49], and

Geer does not explicitly disclose discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number, wherein the second records and the digital images are linked to the records by the first item sequence number and correlating the first and second records.

However, Josephson discloses correlating the first and second records [see entire document particularly, Abstract; Figures; C1 L36-L58; C3 L32 to C5 L9; C8 L35-L51; C27 L37 to C28 L3 – see “correlated item sequence numbers assigned ...”] to cross reference one item sequence number with other for reconciling paper checks to electronic check records.

Cahill discloses a method and apparatus for storing and retrieving images of documents, e.g. checks [see entire document particularly, Abstract; Figures 1-5, 2730; C1 L1 to C10 L62] and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number [C15 L43-L67] to improve database management of document retrieval and quickly access using indexed record.

Ramsay discloses wherein the second records and the digital images are linked to the records by the first item sequence number [Abstract; C30 L55 to C31 L59] to correlate first item serial number with second item (frame number) for identifying and retrieving an item. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Geer and Ramsay to capture the image of an item and assign a sequence number to the image and combine Geer and Ramsay with Josephson to relate the image sequence number to serial number of the item (cross reference) and combine Geer and Ramsay with Josephson with Cahill for indexing the image sequence number with respect to item serial number and store the new indexed table for improved database managing of document retrieval using indexed record.

Re. Claim 2, Geer discloses further comprising performing financial processing with respect to each of the first records [Geer -C3 L30-L55; C4 L26-L42].

Re. Claim 3, Geer discloses wherein the financial processing comprises posting the banking transaction [Geer-C3 L30-L55; C4 L26-L42].

Re. Claim 4, Josephson, further discloses wherein the step of correlating the first and second records further comprises performing a proofing process [abstract] to cross reference one item sequence number with other. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the

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disclosures of Geer, Ramsay, Josephson and Cahill to produce indexable table to correlate one item with other for ease of search.

Re. Claim 5, Cahill further discloses prior to the proofing process, sorting the ECP file according to a key to generate an index file, wherein the order of the seconds is thereby irrelevant in the proofing process [C9 L32-L36; C29 L1-L40] to use as a primary key. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Geer, Ramsay, Josephson and Cahill to revive image record using index as an alternate search key.

Re. Claim 6, Geer discloses wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paperbased banking transaction [Geer - C7 L38-L62].

Re. Claim 8, Geer discloses further comprising storing the digital images in an archive [C8 L10-L67; C15 L17-L19; C17 L5-L8].

Re. Claim 9, Geer discloses further comprising generating first digital images of paperbased banking transactions that were not represented in the ECP file (electronic files that mirror paper cash letters and detail records) [C4 L26-L42; C8 L9-L67].

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Re. Claim 10, Geer discloses generating second digital images of the paper-based banking transactions that were represented in the ECP file, and storing the first and the second digital images in an archive [C8 L9-L67; C15 L7-L19; C17 L5-L8].

Re. Claim 36, claim 36 is rejected with same rational as claim 1.

Re. Claim 37, claim 37 is rejected with same rational as claim 2.

Re. Claim 38, claim 38 is rejected with same rational as claim 3.

Re. Claim 39, claim 39 is rejected with same rational as claim 4.

Re. Claim 40, claim 40 is rejected with same rational as claim 5.

Re. Claim 41, claim 41 is rejected with same rational as claim 6.

Re. Claim 43, claim 43 is rejected with same rational as claim 8.

Re. Claim 44, claim 44 is rejected with same rational as claim 9.

Re. Claim 45, claim 45 is rejected with same rational as claim 10.

Response to Arguments

4. In response to Applicant argument recited in page 6 "The claim limitation states "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number" ...according to Merriam-Webster Online dictionary." Examiner failed to find any reference in disclosure of original specification, which describes the discarding function, to allow the examiner to properly understand the claimed limitation and do proper search, as it is explained in objection of specification section (above). In examiner's view there is a missing portion

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or limitation. How a second sequence number, which is in second record is deleted and it is indexed by the first sequence number. How the second record got the first sequence number assigned to it in first place and then it would be indexable, clearly, there is a missing processing step. Creating indexes, dropping index and re-indexing, dropping column(s), ignoring column(s) and joining tables are well known in relational database and are prior art. Therefore the above limitation it is not clear and there is no example or explanation in specification to clarify this limitation.

In response to Applicant argument recited 7 "receiving the paper-based banking ... " see Geer's col. 10 lines 50-53, which states "electronic transfer and processing of payments occur and paper checks follow at some later time for confirmation, reconciliation and storage by the payor bank and/or for return to the drawer", and col. 5 lines 10-13 "sends the paper checks ... collection system" (means that the check clearing and collection system, which is a payor, receives it and it is well known that the payor bank after receiving the physical check from payee bank mails the physical check to payor).

In response to Applicant argument recited in page 8 "Josephson correlates item sequence number assigned by other banks ..." that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Josephson correlates item sequence number assigned by other banks ...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant argument recited in page 8 “Cahill does not assign a unique second item sequence number to second records, correlating ...” Correlating records are disclosed by, secondary reference, Josephson see Abstract for “correlate item sequence numbers assigned to checks by other banks with different item sequence numbers originally assigned to these checks by the presenting bank. It also provides the capability to reconcile paper checks to electronic check records, even in the event that the paper checks are not in the same order as the electronic check records.”

In response to Applicant argument recited in page 8 “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number.” See Cahill col. 3 lines 62-65 discloses ability to index and store check image in relational database, col. 15 lines 28-31, lines 43-65 shows indexing of Tiff image which is associated with other references such as: check number, amount, date and pointer. Cahill figure 5 shows record (second record) where a tiff file is associated with account #, check number, etc, and assigns a sequence number to BLOB which determines a path to image file (col. 28 line 43 to col. 29 line 16). It is obvious that index database controller of Cahill can index on any column of the record; similarly Cahill system is able to delete a column after records are indexed. It would be obvious that a sequence is a column and it can be removed from a table. Cahill’s record is

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disclosed in figure 5, Cahill does not explicitly disclose a wherein the second records and the digital images are linked to the records by the first item sequence number, but this feature is disclosed by Ramsay (see abstract and col. 30 line 55 to col. 31 line 59; col. 22 lines 8-17). It would be obvious to link an image (column) from one table to another table if they are related by a common referential key.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention and they are stated in rejection after the references.

In response to this office action applicant must add a statement no new matter is added.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass

Application/Control Number: 09/728,340

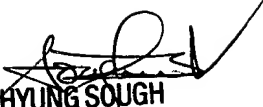
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Examiner

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HTD


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
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